UNITED STATES: PARADISE Won

Despite finding some of the applicant’s goods “legally identical” to the goods covered by a third party’s registered mark and despite the term AQ’s being common to both marks, the Trademark Trial and Appeal Board (TTAB) reversed the refusal of an examining attorney to register the mark AQ. In re Kose Corp., Serial No. 77519214 (T.T.A.B. Apr. 26, 2010).

Kose Corporation filed an application to register the AQ mark for “cosmetics, perfumes, cosmetic soaps, cotton for cosmetic use and hair care preparations” (Class 3) and “eyebrow brushes, cheek brushes, eye shadow brushes, mascara combs, compacts sold empty, lip brushes, powder puffs and foundation sponges for applying makeup” (Class 21). The examining attorney refused registration on the ground that the mark was likely to be confused with the prior-registered trademark PARADISE MAKEUP AQ, covering “makeup” (Class 3).

Although it reviewed each of the likelihood-of-confusion factors set forth in In re E.I. du Pont de Nemours & Co., 177 U.S.P.Q. 563 (C.C.P.A. 1973), the TTAB focused on two factors: the similarities between the goods and between the marks.

The TTAB concluded that the goods sold under the marks at issue were “legally identical” with regard to Class 3 and were closely related and complementary with regard to Class 21. The Board said it presumed the goods covered by the marks traveled in the same channels of trade and were available to the same classes of customers.

But, notwithstanding the close similarity of the goods, the TTAB determined that the marks were dissimilar in appearance, sound, connotation and commercial impression. It rejected the examining attorney’s position that because the letters AQ were common to both marks, those letters should be given greater weight in the likelihood-of-confusion analysis.

Instead, the TTAB concluded that the word PARADISE was the dominant element in the registrant’s mark and that the generic term MAKEUP had the effect of emphasizing the word PARADISE. In the Board’s view, the letters AQ came at the end of the registrant’s mark, almost as an afterthought, and were not dominant. Accordingly, the TTAB reversed the refusal of registration.

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